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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,835	12/12/2001	Ernie F. Brickell	884.437US1	9613
21186	7590	06/30/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938			SHERR, CRISTINA O	
		ART UNIT		PAPER NUMBER
		3621		

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/017,835	BRICKELL ET AL.
	Examiner	Art Unit
	Cristina Owen Sherr	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 April 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-22 and 24-43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the applicant's amendment filed April 7, 2005. Claims 1,7, 13, and 27 have been amended. Claim 23 has been canceled. Claims 1-22 and 24-43 are pending in this case.

Response to Arguments

2. Applicant's arguments with respect to claims 1-22 and 24-42 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 7, 13, and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

5. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

6. In the present case, claims 7, 13, and 27 only recite an abstract idea. The recited steps of merely providing an authentication service, through a set of a plurality of authentication mechanisms, wherein a user is granted or denied access to a service or information does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to select an authenticate or verify the identity of a user.

7. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces the authentication of the identity of a user (i.e., repeatable) used in verifying the right to certain services or information (i.e., useful and tangible).

8. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, independent claims 7, 13, and 27 and their dependent claims 8-12, 14-22, 24-26, and 28-40 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Elander et al (US 4,500,750).

11. Regarding claim 1 –

Elander discloses a method of providing an authentication service, comprising: relating a user identity to a set of a plurality of authentication mechanisms; relating a type of transaction with a relying party to a level of authentication; and authenticating the user identity through at least one authentication mechanism in the set of the plurality of authentication mechanisms for the type of transaction, according to the level of authentication (e.g. col 5 p 8 – col 6 p 2).

12. Regarding claims 2-6 –

Elander discloses the method as recited in claim 1, further comprising: selecting the at least one authentication mechanism depending on the plurality of authentication mechanisms related with the user and the level of authentication (e.g. col 5 p 6); further comprising: monitoring a series of authentications for the relying party to detect fraud (e.g. col 5 p 6); wherein the authentication mechanisms in the set of authentication mechanisms are part of a distributed system (e.g. col 6 p 7); wherein at least one of the authentication mechanisms is mobile (e.g. col 2 p 3); a computer-readable medium having computer-executable instructions for performing the method as recited in claim 1 (e.g. col 2 p 3).

13. Claims 41-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Elander et al (US 4,500,750).

14. Regarding claim 41 –

Elander discloses a method of authentication, comprising: requesting, by a user to a relying party, a protected service; sending, by the relying party, a description of the request to an authorization server; determining, by the authorization server, a first level of assurance; sending, by the authorization server to an authentication server, the first level of assurance; requesting, by an authentication server, authentication from the user; entering, by the user, authentication information into an authentication device; sending, by the authentication device to the authentication server, authentication information; verifying, by the authentication server, the authentication information using authentication verification information stored in a portfolio in a database that is associated with the user; computing, by the authentication server, a second level of assurance; evaluating whether the second level of assurance is high enough; sending, by the authentication server to the authorization server, a first success message, upon determining the second level of assurance is high enough; verifying, by the authorization server, information from the authentication server; verifying, by the authorization server, that the user is allowed to perform the protected service; sending, by the authorization server to the relying party, a second success message, upon verification of the information from the authentication server and verification that the user is allowed to perform the protected service; and providing, by the relying party to the user, the protected service (e.g. col 2 p 10 – col 3 p 1).

15. Regarding claims 42-43 –

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Elander discloses the method as recited in claim 41, further comprising: requesting, by the authentication server to the user, authentication using at least one additional authentication method, upon determining the second level of assurance is not high enough; further comprising sending, by the authentication server to the authorization server, a first failure message and a reduced level of assurance, upon determining the user is unable to authenticate using the at least one additional authentication method; storing, by the authorization server, the reduced level of assurance; sending, by the authorization server to the relying party, a second failure message; and providing, by the relying party to the user, a third failure message (e.g. col 5 p 8 – col 6 p 2).

16. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Rubin (US 5,638,446) discloses a method for the secure distribution of electronic files in a distributed environment.

19. Johnson et al (US 5,428,795) discloses a method of and apparatus for providing automatic security control of distributions within a data processing center.

20. Bourbon (US 5,822,408) discloses a method and apparatus for verifying the identity of a receiver of a facsimile.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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